

Application No. 10/801,316

Reply to Office Action

**REMARKS/ARGUMENTS*****Claim Amendments***

Claims 1 and 34 have been amended to more clearly recite that the boric acid or conjugate base thereof is not present in the polishing system in an amount sufficient to act as a pH buffer. The claim amendments are supported by the specification, at, for example, paragraph [0019]. No new matter has been added by way of the claim amendments.

***Summary of the Office Action***

The Office Action rejects claims 1-13 and 34-36 as allegedly unpatentable under 35 U.S.C. § 112. Also, the Office Action rejects claims 1-4, 6-9, 12, and 34-36 as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent 5,858,813 (hereinafter "the Scherber '813 patent") in view of U.S. Patent 6,190,237 (hereinafter "the Huynh '237 patent"). In addition, the Office Action rejects claim 5 as allegedly unpatentable under 35 U.S.C. § 103 over the Scherber '813 patent in view of U.S. Patent 5,692,950 (hereinafter "the Rutherford '950 patent"). The Office Action also rejects claims 10, 11, and 13 as allegedly unpatentable under 35 U.S.C. § 103 over the Scherber '813 patent in view of U.S. Patent 5,954,997 (hereinafter "the Kaufman '997 patent").

***The Section 112 Rejections***

As discussed above, the claims have been amended as desired by the Examiner. Thus, the indefiniteness rejection has been rendered moot with respect to the pending claims and should be withdrawn.

***The Section 103 Rejections***

The Scherber '813 patent generally discloses a chemical-mechanical polishing system which utilizes a polishing slurry comprising an abrasive, an organic acid, and an aqueous medium. The Scherber '813 patent does not disclose the use of boric acid or a conjugate base thereof. The Huynh '237 patent discloses a method for polishing a surface by contacting the surface with a first slurry of pH 1-6 followed by a second and different slurry of pH 3-11 that comprises a pH buffering component comprising at least one acid, salt, or mixture thereof and at least one base, salt, or mixture thereof. The acid, salt, or mixture thereof can be boric acid.

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If one of ordinary skill in the art were to apply the disclosure of the Huynh '237 patent to the disclosure of the Scherber '813 patent, the result would be a polishing system with a pH buffering component comprising an acid, salt, or mixture thereof. Although the acid could be boric acid, the boric acid would be present in an amount sufficient to act as a pH buffer. In contrast, however, the present invention as defined by the pending claims does not contain boric acid or a conjugate base thereof in a sufficient amount to act as a pH buffer.

There is nothing in the Huynh '237 patent or the Scherber '813 patent that would have directed one of ordinary skill in the art to reduce the amount of boric acid or a conjugate base thereof below the amount sufficient to act as a pH buffer. Indeed, for one of ordinary skill in the art to do so would have required the ordinary artisan to ignore, rather than follow, the teachings of the Huynh '237 patent, which extols the virtues of utilizing a pH buffer. Thus, if anything, the combination of the Scherber '813 and Huynh '237 patents teaches away from the present invention.

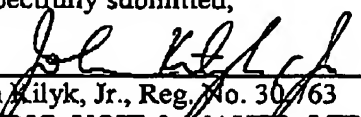
The Rutherford '950 patent and the Kaufman '997 patent do not cure the deficiencies of the Scherber '813 and Huynh '237 patents. Neither the Rutherford '950 patent nor the Kaufman '997 patent discloses the use of boric acid or a conjugate thereof, let alone in an amount less than that sufficient to act as a pH buffer in a chemical-mechanical polishing system.

Under the circumstances, the obviousness rejection is improper and should be withdrawn.

#### *Conclusion*

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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